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In the

Supreme Court of the United States

OCTOBER TERM, A. D. 1918

No. 964 3[redacted]93

BERLIN MILLS COMPANY

Petitioner

vs.

PROCTER & GAMBLE COMPANY

Respondent

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT AND BRIEF IN SUPPORT THEREOF

MARCUS B. MAY
JOHN C. PENNIE
E. HENRY LACOMBE
MELVILLE CHURCH
For Petitioner

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—1919—

IN THE
SUPREME COURT OF THE UNITED STATES.

October Term, A. D. 1918.
No.

BERLIN MILLS COMPANY,
Petitioner.

v.

PROCTER & GAMBLE COMPANY,
Respondent.

Petition for a Writ of Certiorari to the Circuit Court of Appeals for the Second Circuit, and Brief in Support Thereof.

To the Honorable, The Chief Justice and Associate Justices of the Supreme Court of the United States:

Your petitioner, BERLIN MILLS COMPANY, respectfully prays for a writ of certiorari to review the decree of the Circuit Court of Appeals for the Second Circuit in the above-entitled cause.

Question Presented.

The question presented for determination is the soundness or unsoundness, as matter of law, of a decision of the Circuit Court of Appeals for the Second Circuit, whose pronouncements

have great weight as precedents in patent cases—holding that a claim which is, in terms, for a product is sustainable as a claim for a product made by a particular process.

Brief Statement of the Case.

I. The patent involved is No. 1,135,351, for Food Product, granted April 13, 1915, upon an application filed November 10, 1910, to the Procter & Gamble Company, as assignee of John Burchenal.

The food product of the patent in suit is artificial lard. Lard itself is a semi-solid product produced from the fat of hogs.

Artificial or imitation lard is old as produced

(a) by hardening cotton seed oil to a semi-solid consistency by mechanically mixing therewith melted hard animal fat, and

(b) by hardening cottonseed oil to a semi-solid consistency by mechanically mixing therewith melted, hard hydrogenized cottonseed oil.

II. The artificial or imitation lard, or lard-like product, of the patent in suit is produced by hardening cottonseed oil to a semi-solid consistency by incompletely hydrogenizing the oil. The claims of the patent put in issue are the following:

> 1. A homogeneous lard-like food product consisting of an incompletely hydrogenized vegetable oil.

2. A homogeneous lard-like food product consisting of an incompletely hydrogenized cottonseed oil.

III. It is unnecessary for the court to consider the chemical process of hydrogenation by which, when hydrogen is absorbed by the oil in the presence of active nickel, the oil is gradually hardened from a liquid through successive stages of viscosity to a solid, because that process is old and not the invention of the patentee herein, and is not claimed by him in the patent in suit.

Nor is it necessary for the court to consider the chemical or physical aspects of the patented product or of the product of the prior art, for the Court of Appeals has found these products to be substantially identical, both chemically and physically.

IV. Notwithstanding the Court of Appeals found the artificial or imitation lard of the patent in suit to be indistinguishable from the prior art product, it held such product to be patentable because produced by a certain process. On this point of law, the Court of Appeals, with one member, Judge Ward, dissenting, reversed the ruling of the District Court. The judicial mind is thus equally divided.

V. In the majority decision of the Court of Appeals, the following was stated:

> "But before Burchenal many imitation lards were made by mechanically mixing hard animal fats and cottonseed oil in varying proportions, *and some of these mixtures show on analysis substantially the same chemical characteristics as are shown by*

> *Burchenal's chemically produced 'homogeneous semi-solid'.* Therefore it is said that to make the same thing as had been made by earlier lard imitators but in a different way, cannot warrant a patent upon the resulting thing or product, whatever may be true in respect of the process by which that product is reached. This is as much as to say that the Burchenal article when completed and ready for use must be old, because other men had earlier arrived at the same chemical result by other paths."

Again:

> "It may be assumed as true that by the mixture of cottonseed oil and animal stearin a substance can be produced which for practical purposes is the same thing as Burchenal's chemically changed cottonseed oil; but one is a mixture and the other is not; and assuming the difference to be unimportant from the standpoint of either chemist or cook, it is a vital difference from that of the law."

Again, in the memorandum decision of the court following an application for re-hearing, the court said:

> "Our decision is and has been based, on a firm conviction, that what is practically lard consisting solely of one vegetable oil in a state of arrested hydrogenation, is a new thing in the sense of the patent law; almost as new as synthetic egg evolved from vegetable albumen by chemical treatment."

VI. From the above quoted excerpts from the majority opinion of the Court of Appeals, it is perfectly plain that that court held the Burchenal claims to be patentable, not because the product covered by them was different from, or

distinguishable by chemists or expert users from, the product of the prior art, but because it was produced by a particular process recommended and set out by Burchenal in the body of his patent, namely, by a process of incompletely hydrogenizing vegetable oil. In other words, the majority of the court held that, although the two products—the old product and Burchenal's product—were practically identical, Burchenal's was patentably different because it was made in a new way. The opinion went so far as to assume that a synthetic egg, although identical in all respects with a natural egg, would be patentable as a new product because it was produced in a new way, or by a new process; overlooking the fact that the distinguishable feature of the achievement was not to be found in the result, but in the method or process by which the result was reached.

VII. Such a holding strikes down all distinctions between the various patentable subjects matter defined by the Statute, i. e. "art (process), machine, manufacture, or composition of matter" (Sec. 4886, R. S. U. S.); renders nugatory the statutory requirement that a patentee "shall particularly point out and distinctly claim" his invention (Sec. 4888, R. S. U. S.); and is, furthermore, at war with the decisions of this court defining the difference between processes and products considered as patentable subjects.

VIII. In the Wood Paper Patent Case (23 Wall., 566) (1873), this Court held that a manufacture or product of a process *may not* be new, and therefore unpatentable; while the process or

agency by which it is produced may be patentable; and it further held that the product claimed in that case, *i. e.,* paper pulp extracted from wood by chemical agencies, alone, is not a different *manufacture* from paper pulp obtained from vegetable substances by chemical and mechanical processes.

If to that same court there had been submitted a claim to

> "A homogeneous lard-like food product consisting of an incompletely hydrogenized vegetable oil",

and it appeared, as found by the Court below in this case, that a product similar to that claimed, and indistinguishable from it by "chemist or cook", was old, there can be no doubt that such claim would have promptly been held invalid.

In *Merrill v. Yeomans,* (94 U. S. 568) (1876), this Court found that the patentee had made three separate inventions, *i. e.,* (1) a new machine or apparatus, (2) a new process, and (3) a new product. He had, however, made but two claims; one of these was, plainly, for an apparatus and was not infringed by the defendant; the other claim was contended by the plaintiff to be for a product and by the defendant to be for a process.

The Court, after a careful analysis of the disclosure of the patent, held the claim to be for a process and that the defendant didn't infringe it because he employed a different process.

Out of tenderness for a patentee, however, the Court actually suggested that a reissue be applied for to cover the product which the original patent had failed to cover, saying (p. 573):

> "If the patentee is also entitled to a patent

> for the product of this distillation and has failed, as we think he has, to obtain it, the law affords him a remedy, by a surrender and reissue."

In *Powder Company v. Powder Works* (98 U. S. 126) (1878), this Court again accentuated the difference between process and product, holding them to be distinct and different things under the patent law.

IX. In the case at bar, on the findings of the Court below, the product claimed in the Burchenel patent, being indistinguishable, as such, from the products of the prior art, though made by a slightly different process, should be deemed to be unpatentable and the judgment below reversed.

X. It is submitted that the time has arrived when the ancient decisions of this Court, above referred to, should be reaffirmed and re-established, lest the inferior Courts stray further and further from correct principles and erect new precedents that will produce only confusion and uncertainty in the administration of the law.

More than once has this Court so interposed to re-establish a principle of patent law on a firm basis.

XI. It is respectfully submitted that the case at bar is one of gravity and importance not only with respect to the petitioner, whose operations were begun long before the issuance of the patent sued upon, but also with respect to vital interests of the public.

One of the results of the recent war has been a great shrinkage in the stock and in the production of such semi-solid edible fats. Heretofore, a

large proportion of such fats has been obtained from animal substances. A great reduction in the available live stock from which edible fats may be obtained, makes it important for the health of large communities to secure, if possible, a sufficient supply of such fats from other sources, for without a proper proportion of edible fats in the dietary, malnutrition results.

The patent has been so broadly construed by the Court of Appeals as to substantially cover all semi-solid edible fats of vegetable origin, notwithstanding that such products are indistngushable by chemist or cook from prior art products. In the face of the monopoly secured by such construction, hosts of producers who would otherwise contribute to restore the balance lost by the shrinkage of available animal fats, will find it impossible thus to contribute; but the present situation makes it a matter of public interest that such balance be restored as quickly and as fully as possible. Whether any single producer could accomplish this result may well be doubted.

It is not intended to suggest that a patent which secured a monopoly in the production of a certain article should be held of no effect merely because the public is affected by such results; but it is respectfully submitted that when such is the result, and large numbers of people are affected thereby, public interests require that so broad a construction be given to the patent, only after a judicial examination which leaves no doubt as to the correctness of such construction.

The ruling of the Court of Appeals affects not only the consumers, but it directly affects the

growers of cotton, peanuts and other oil-producing vegetable products, and also the manufacturers who produce the oil therefrom and the manufacturers who employ such oil in the production of cooking fats. It would be oppressive to deprive the public of the right to use in its dietary old food products, stated by the Court to be indistinguishable from the alleged new product, because some one claims to have produced such old products in a new way, which new way may or may not be patentable, as a *process*.

Respectfully,

MARCUS B. MAY,
JOHN C. PENNIE,
E. HENRY LACOMBE,
MELVILLE CHURCH,
Counsel for Petitioner.

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BERLIN MILLS COMPANY,
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Notice.

To the Procter & Gamble Company or its attorneys:

Please take notice that upon a certified copy of the transcript of record herein, I shall present the petition for writ of certiorari hereunto annexed, before the Supreme Court of the United States at the Capitol in the City of Washington, District of Columbia, on the 21st day of April A. D., 1919, at the opening of Court on that day, or as soon thereafter as counsel can be heard, and that I shall then and there move for such other and further relief in the premises as may be just.

JOHN C. PENNIE,
Solicitor for Petitioner.

New York, N. Y., April 4, 1919.

To
THOMAS B. KERR, Esq.,
New York, N. Y.

Due service of the foregoing petition and brief in the above entitled cause are hereby admitted this 4th day of April, 1919.

THOMAS B. KERR,
Solicitor for Respondent.